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OFFICE OF PETITIONS

In re Application of :
Roy L. Barrus, et al. :
Application No. 10/016,276 : **DECISION ON PETITIONS**
Filed: December 6, 2001 : **UNDER 37 CFR 1.78(a)(3) AND (a)(6)**
Attorney Docket No. SHP024.2 :

This is a decision on the petition filed November 12, 2004, which is being treated as a petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed applications set forth in the amendment filed May 14, 2004.

The petitions are **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1) noted above.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming benefit of one or more prior-filed copending applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

The reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference those prior-filed applications. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See In re deSeversky, supra. Note also MPEP 201.06(c).*

In the concurrently filed amendment, it is stated, "...U. S. Utility Patent Application Serial No. 09/619,190, filed July 19, 2000, which claims benefit of U. S. Provisional Application Serial No. 254,506 filed in the USPTO on December 8, 2000 by Thorne et al., U. S. Provisional Application Serial No. 60/275,886, filed March 14, 2001 and U. S. Provisional Application Serial No. 60/296,968 filed in the USPTO on June 8, 2001 by Barrus et al..."

An application cannot claim priority to a subsequently filed application. The three provisional applications were filed after the aforementioned nonprovisional application (Application No. 09/619,190). If petitioner is claiming benefit of the provisional applications to the instant application (Application No. 10/016,276), then a substitute amendment indicating such should be submitted.

Before the petition under 37 CFR §§ 1.78(a)(3) and 37 CFR 1.78(a)(6) can be granted, a substitute amendment or an Application Data Sheet (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) deleting the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(6), is required.


Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Marianne Jenkins at (571) 272-3223.


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